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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,416	01/22/2001	Derek J. Whiteside	10007090-1	2465

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HEWLETT-PACKARD COMPANY
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EXAMINER

DUNCAN, MARC M

ART UNIT PAPER NUMBER

2184

DATE MAILED: 09/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,416

Applicant(s)

WHITESIDE ET AL.

Examiner

Marc M Duncan

Art Unit

2184

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-29 is/are rejected.
- 7) ☒ Claim(s) 2,3,5,11 and 20-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 12, 15-16 and 19-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "substantial portion" in claims 1, 7, 12, 19, 25, 27 and 29 is a relative term that renders the claim indefinite. The term "substantial portion" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Appropriate correction is required.

The term "certain portion" in claims 15 and 16 is a relative term that renders the claim indefinite. The term "certain portion" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Appropriate correction is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 17 states that the network server receives software including an updated version of the software package installed during manufacturing of a computing device. The specification does not support this. The examiner believes the computing device receives the updated version of the software.

Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 24 states that a network location is transmitted to a web site available by way of the World Wide Web. This is not supported by the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 6, 8-10, 13-16, 18-19 and 25-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Britt, Jr. et al.

Regarding claim 1:

Britt teaches transmitting an identifier to a network location, said identifier being an attribute of a particular computing device in col. 11 lines 44-46.

Britt further teaches receiving recovery software from said network location, said recovery software including a substantial portion of a software package installed during manufacturing of said computing device in col. 2 lines 7-22.

Regarding claim 4:

Britt teaches the identifier being read from a read-only memory in col. 11 lines 27-29 and 44-46.

Regarding claim 6:

Britt teaches the network location being a web site available by way of an interface to the World Wide Web in col. 11 lines 27-29.

Regarding claim 8:

Britt teaches receiving software including an updated version of the software package installed during manufacturing of said computing device in col. 12 lines 6-8.

Regarding claim 9:

Britt teaches receiving, by way of a network interface, an identifier that originated from said computing device in col. 11 lines 44-46.

Britt teaches determining, based on said identifier, a software package previously installed on said computing device during manufacturing of said computing device in col. 11 lines 44-46.

Regarding claim 10:

Britt teaches the network interface being an interface to the World Wide Web in col. 11 lines 27-29.

Regarding claim 13:

Britt teaches assembling the software package previously installed on said computing device during said manufacturing in col. 11 lines 45-46.

Regarding claim 14:

Britt teaches transmitting said software package previously installed on said computing device to said computing device by way of said network interface in col. 11 lines 44-65.

Regarding claim 15:

Britt teaches determining if an updated version of a certain portion of said software package previously installed on said computing device is available in col. 2 lines 23-34.

Regarding claim 16:

Britt teaches transmitting the updated version of said certain portion of said software package to said computing device in col. 12 lines 6-8.

Regarding claim 18:

The claim is rejected as the computer program product for performing the method of 1.

Regarding claim 19:

The claim is rejected as the apparatus for performing the method of claim 1.

Regarding claim 25:

The claim is rejected as the program product for performing the method of claim 1.

Regarding claim 26:

Britt teaches the network being the Internet and the network location being available on the World Wide Web in col. 2 lines 50 and col. 11 lines 27-29.

Regarding claim 28:

The claim is rejected as the program product for performing the method of claim 8.

Regarding claim 29:

Britt teaches said computing device transmitting an identifier to a network location, said identifier being an attribute of a particular computing device in col. 11 lines 44-46.

Britt teaches receiving, by way of a server positioned at the network location, an identifier that originated at said computing device in col. 11 lines 44-46.

Britt also teaches the server determining, based on said identifier, a software package previously installed on said computing device during manufacturing of said computing device in col. 11 lines 44-46.

Britt further teaches said computing device receiving recover software from said network location, said recovery software including a substantial portion of a software package installed during manufacturing of said computing device in col. 2 lines 7-22.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7, 12 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Britt, Jr. et al. in view of Kroening et al.

The teachings of Britt are outlined above.

Britt does not expressly teach a software package including customized software. Britt does, however, teach a computing device with an installed software package.

Kroening teaches a software package including customized software in the Abstract lines 1-4.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Kroening's customized software with the software package of Britt.

One of ordinary skill in the art at the time of invention would have been motivated to combine the teachings because Kroening discloses that the use of custom software

packages saves time and expense for a manufacturer to satisfy a purchasing customer's computing needs in col. 1 lines 58-59 and col. 2 lines 5-6.

Allowable Subject Matter

Claims 2-3, 5, 11 and 20-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Prior art was not found that expressly teaches or fairly suggests the use of an input device to input the identifier as outlined in claims 2 and 20. Prior art was not found that expressly teaches the identifier being a serial number of the computing device as outlined in claim 5, 11 and 23. These limitations are considered allowable only when taken in combination with the base claim from which they depend and all intervening claims.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art not relied upon contains elements of the instant claims and/or represents a current state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc M Duncan whose telephone number is 703-305-4622. The examiner can normally be reached on M-T and TH-F 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on 703-305-9713. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

md


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